



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/809,621	06/02/97	IDA	N 599-158P

002292
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HM22/0801

EXAMINER

SUN HOFFMAN, L

ART UNIT

PAPER NUMBER

1642

21

DATE MAILED: 08/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

08/809,621

Applicant(s)

Ida et al

Examiner

Lin Sun-H ffman

Group Art Unit

1642



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 2 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on Jun 22, 2000 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on May 19, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

- ☒ will not be entered because:

☒ they raise new issues that would require further consideration and/or search. (See note below).

☒ they raise the issue of new matter. (See note below).

☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: the term "interferon-gamma" requires new search. "the bone disorder is NOT Paget's ..." is not supported by the specification, and it deems to be a new matter.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached Office Action.

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: 7, 9, 10, and 13-15

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s) ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

- ☐ Other

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DETAILED ACTION

1. Applicant states that "the Examiner is reminded that she indicated this Amendment would be entered even though the application is in the after-final stage of prosecution." No record has shown such a statement has been made. Entering an after-final amendment depends on review of the claims. In the present after-final amendment, the new matter has been entered and the scope of the search has be broadened as indicated in the previous page, therefore, the after-final amendment is not entered.

2. Rejections to claims 7, 9 and 10 are moot due to the cancellation of the claims.

3. Since the present claims are not being entered, the response to the argument is based on the original claims.

Rejection to claim 13 under 102(b) as being anticipated by Gomi et al is maintained as in the Office Action mailed on 12/22/99.

4. Rejections to claims 13 and 14 are maintained under 102 (b) and 103 over Modi as in the Office Action mailed on 12/22/99.

Applicant submitted a declaration under rule 1.132. In the declaration, applicant stated that no literature was available teaching the use of IFN-beta for the therapeutic treatment of osteoporosis before Modi et al., and provided a list of reference. However, no copies of reference has submitted, therefore, the Office cannot evaluate applicant's allegation..

In addition, applicant also argue that Modi's statement is only wishful thinking because administration of IFN-gamma to an osteoporosis patient already suffering from a decrease in bone volume, would lead to an increased state of osteoporosis. The argument seems to be

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contradictory to the claimed invention. If IFN-gamma is not able to treat osteoporosis as alleged by the applicant, then the claims are not enabled; therefore, this argument is not persuasive.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Sun-Hoffman, Ph.D., whose telephone number is (703)-308-7552. The examiner can normally be reached on Monday to Friday from 7:30 am to 4:00 pm Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Caputa, Ph.D., who can be reached on (703) -305-3995.

Lin Sun-Hoffman, Ph.D.

July 18, 2000



ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600